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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,387	01/31/2001	Herbert F. Cattell	10010009-1	7825

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EXAMINER	
ALLEN, MARIANNE P	
ART UNIT	PAPER NUMBER
1631	8

DATE MAILED: 01/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/775,387	CATTELL, HERBERT F.	
	Examiner	Art Unit	
	Marianne P. Allen	1631	

-- The MAILING DATE of this communication appears on the cover she t with the correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 October 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-36* is/are pending in the application.

4a) Of the above claim(s) *14-24 and 34-36* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13 and 25-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-36* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 5/7/01 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4,7* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group I, claims 1-13 and 25-33, in Paper No. 6 is acknowledged.

Claims 14-24 and 34-36 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6.

Claim Rejections - 35 USC § 112

Claims 6, 10-13, 28, and 31-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6 and 28 are confusing in reciting "in accordance with the retrieved biological function data." This limitation appears to intend that the retrieved biological function data in some way directs the processor to read the array or process information in a different manner based upon the information retrieved. The claims as written do not make clear what positive, active step is to occur nor the criteria determining whether such an action will or will not occur.

Claim 10 lacks antecedent basis in claim 9 for the recitation "biopolymer identity data obtained." Claim 9 is directed to retrieving biological **function** data and does not recite identity data.

Claim 11 is confusing in reciting "obtaining a communication address of the remote station using the identifier signal." It is unclear if the communication address is intended to be embedded or encoded within the identifier signal (i.e. part of a bar code) or if the identifier

provides direction to retrieve a communication address from some other place. If the latter was intended, the claim does not make clear how this information is to be retrieved using the identifier signal or from what source.

Claim12 appears to be incomplete. It does not appear that communicating an identifier signal alone would result in retrieval of biological function data. It appears that a program, protocol or method step is missing. This claim does not appear to further limit the subject matter of claim 9 as the method of claim 9 appears to include the recited communication and retrieval. Likewise, claim 13 does not appear to be further limiting as the recitation "memory carrying multiple identifiers in association" would appear to be an implicit limitation of claim 9. That is, the method of claim 9 must have the data in a memory and data for multiple identifiers.

Claim 26 in confusing in not clearly further limiting the apparatus of claim 25. The limitations of claim 26 are method limitations that do not clearly further define the apparatus, particularly the processor, of claim 25.

Similarly, claims 31-33 are confusing in not clearly further limiting the apparatus of claim 30. The limitations of these claims concern the data communicated but do not further define the apparatus, particularly the processor, of claim 30.

Claim 31 is confusing in reciting "along with an indication of a suspected feature error." It is not known what information must be communicated to meet this limitation. The meets and bounds of what is intended do not appear to be disclosed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-13, 25-30, and 32-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Muraca (U.S. Patent Application Publication No. 2002/0168639).

Muraca et al. discloses profile array substrates having addressable arrays wherein the array contains an identifier such as a bar code or microchip. The identifier can communicate with a processor to provide biological function data for one or more of the biopolymers on the array. The biopolymers evaluated on the array can be proteins or nucleic acid sequences. The database is coupled to an information management system to retrieve information about a material on the array. The information can be retrieved following exposing the array to a sample. The information can be communicated through e-mail or through a wireless communication device thus meeting the limitation of a remote station. (See at least paragraphs 0029-0030, 0034, 0083, 0086-0088, 0144, and 0183 as well as claims.) Basis for the disclosure relied upon is present in provisional application 60/234,493, filed 9/22/00.

Claims 1-13, 25-30, and 32-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Doung et al. (U.S. Patent Application Publication 2002/0177135).

Doung et al. discloses addressable arrays such as for DNA nucleic acids and methods of assaying these arrays. These biochip cartridges can have bar code identifiers. The apparatus disclosed can include a bar code reader. Data about the cartridge can be displayed. The bar code can provide identification information or other biological information concerning the array as well as control the apparatus. The apparatus can communicate data assay results, barcode information, etc. to a remote location. (See at least abstract, Figures 11-13, and paragraphs 0330-0335 and 0354-0358.) It is noted that while the first page of this document references provisional application 60/145,840, this number is a typographical error. The correct provisional application is 60/245,840, filed 11/30/00. Basis for the disclosure relied upon is present in this provisional application.

Claims 1-3, 5, 7-12, 25, 27, 29-30, and 32-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Schembri (GB 2,319,833).

Schembri discloses use of an addressable array of biopolymers such as DNA where information regarding each biopolymer can be retrieved from a tagged file. The file can be linked to the array by means of a silicon chip, magnetic strip, or bar code on the array. See pages 6 and 11. The specification provides no limiting definition for biological function data. As such, identification of the biopolymer is deemed to meet this limitation as the name would provide biological function information to one of ordinary skill in the art.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dorsel et al. (U.S. Patent No. 6,406,849) discloses a method and apparatus in which the array package includes an identification such as a bar code. (See columns 6-7, bridging paragraph, and Figure 5.) The identification may include instructions or be associated with a database. There is no disclosure that the identifier signal may be associated with biological function data.

Stern et al. (U.S. Patent Application Publication No. 2002/005512) discloses a method and apparatus in which the array package includes an identification such as a bar code. (See paragraph 99.) The identification may include instructions or be associated with a database. There is no disclosure that the identifier signal may be associated with biological function data.

Chin et al. (U.S. Patent No. 6,470,277) discloses using an array of biopolymers having a bar code identifier in a method of identifying candidate genes. (See Figures 3 and 8; column 2, lines 10-20; columns 9-10, bridging paragraph; column 11, lines 15-30; columns 15-16, bridging paragraph.) The method disclosed is directed to using sequence homology data to integrate information from various sources including the arrays of biopolymers used to determine expression under different conditions. The specific steps of the method and apparatus therefore claimed in the instant application are not disclosed nor fairly suggested by the reference.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen whose telephone number is 703-308-0666. The examiner can normally be reached on Monday-Friday, 8:30 am - 2:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 703-308-4028. The fax phone numbers for

the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Marianne P. Allen
Primary Examiner
Art Unit 1631

mpa
January 13, 2003